

REMARKS

Claims 11-24 are pending in the application.

Claims 11 has been amended as the Examiner suggest to change "structure" to "substrate."

Claims 22-24 have been amended to correct their dependencies.

No new matter has been added.

Rejections under 35 U.S.C. § 102

Claims 11, 12, 14-16, 20, 22, 23 and 24 stand rejected under 35 U.S.C. § 102 as anticipated by Gorrell, U.S. 3,647,508. According to the Examiner, Gorrell teaches a process for the partial demineralization of a multilayer substrate as claimed.

The Examiner recognizes that Gorrell does not teach a co-extruded film comprising a polyethylene film and an adhesive layer, and eliminating the chemical reactivity of the etchant towards the adhesive layer. It is the Examiner's position, however, that "since the claim does not recite any steps including an adhesive layer, or a co-extruded film comprising a polypropylene layer, the steps are not given patentable weight . . ." (Office Action, p. 3)

Applicants respectfully disagree with the Examiner's analysis. To anticipate a claimed invention under 35 U.S.C. § 102, a reference must teach each and every element of the claimed invention. Given that Gorrell does not teach each and every element, Gorrell can not anticipate the claims. Although the Examiner admits that the Gorrell does not teach each and every element of the claims, the Examiner does not cite any authority for his conclusion that the claims must recite something other than they do in order to be patentable. Applicants respectfully ask the Examiner to provide authority for his position if he intends to maintain it.

Furthermore, the Examiner has misinterpreted the teaching of Gorrell. For example, the Examiner refers to col. 3, lines 45-50 as teaching a substantially transparent window in the metallic

layer. This portion of the specification, however, does not teach anything about a "substantially transparent" window as recited in claim 1.

Accordingly, because Gorrell does not teach each and every element of claim 1, and in the absence of any authority from the Examiner that would support the basis for the rejection, Applicants respectfully request that the Examiner withdraw the rejection under 35 U.S.C. § 102(b) over Gorrell.

Rejections under 35 U.S.C. § 103

Claims 13, 19 and 21 stand rejected under 35 U.S.C. § 103(a) as being obvious over Gorrell in view of Wilson, U.S. 4,959,120.

The Examiner finds that Wilson teaches the use of a second laminate as in claim 13, and the fine tuning the etchant concentration and choosing the correct cylinder depth as in claims 19 and 21.

Because claims 13, 19 and 21 depend from claim 11, these claims contain all of the limitations of claim 11. The Examiner does not cite Wilson to resolve any of the deficiencies of Gorrell as noted above for claim 11. Accordingly, the combination of Gorrell and Wilson can does not render obvious claims 13, 19 and 21. Therefore, Applicants request that the rejection be withdrawn.

Claims 17 and 18 stand rejected under 35 U.S.C. § 103(a) as being obvious in view of Gorrell in view of the admitted prior art in the specification. The Examiner finds that the specification admits the teaching of the prior art related to coating and printing operations for treating a multilayer substrate.

Because claims 17 and 18 depend from claim 11, these claims contain all of the limitations of claim 11. The Examiner does not cite the purported admitted prior art in the specification to resolve any of the deficiencies of Gorrell as noted above for claim 11. Accordingly, the combination

of Gorrell and the specification can does not render obvious claims 17 and 19. Therefore, Applicants request that the rejection be withdrawn.

CONCLUSION

There may be other reasons for patentability for independent and dependent claims, and Applicants do not waive those arguments by failing to assert those arguments here. Applicants view the foregoing reasons as sufficient to establish that the claims are nonobvious, but Applicants expressly reserve the right to make further argument regarding patentability of the claims in future proceedings.

Applicants respectfully submit that with the above Amendments and Remarks, the claims are now in a condition for allowance. If the Examiner is of the opinion that a telephone conference would expedite prosecution of the application, the Examiner is encouraged to contact Applicants' undersigned representative.

Respectfully submitted,

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